

Application No. 10/666,901
Amendment Dated March 13, 2006
Reply to Office Action of September 27, 2005

REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed September 27, 2005. A petition and fee for a three month extension of time is attached.

In that Office Action, the Examiner rejected claims 1-5, 9 and 11 under 35 U.S.C. §102(e) as being “anticipated” by U.S. Patent No. 6,818,274 (*Buck*), rejected claim 1 under 35 U.S.C. §102(e) as being “anticipated” by U.S. Publication No. 2003/0175474 (*Higgins*), rejected claim 1 under 35 U.S.C. §102(b) as being “anticipated” by U.S. Patent No. 4,426,415 (*Avery*), rejected claims 6 and 7 under 35 U.S.C. §103(a) as having been “obvious” over *Buck* in view of U.S. Patent No. 4,336,286 (*Tomarin*), rejected claim 8 under 35 U.S.C. §103(a) as having been “obvious” over *Buck* in view of U.S. Patent No. 4,152,473 (*Layman*), rejected claim 10 under 35 U.S.C. §103(a) as having been “obvious” over *Buck* in view of U.S. Patent No. 5,939,166 (*Cheng*), rejected claim 12 under 35 U.S.C. §103(a) as having been “obvious” over *Buck* in view of U.S. Patent No. 6,051,300 (*Fink*), rejected claims 6 and 7 under 35 U.S.C. §103(a) as having been “obvious” over *Avery* in view of *Tomarin*, rejected claim 8 under 35 U.S.C. §103(a) as having been “obvious” over *Avery* in view of *Layman*, rejected claim 10 under 35 U.S.C. §103(a) as having been “obvious” over *Avery* in view of *Cheng*, and rejected claim 12 under 35 U.S.C. §103(a) as having been “obvious” over *Avery* in view of *Fink*.

In this Amendment, claim 1 has been amended to incorporate the limitations of claim 3 and claim 6. Claims 3 and 6 have in turn been cancelled. This application now contains a total of ten claims. Of these, claim 1 is presented in independent form. Claims 2, 4-5 and 7-12 depend on independent claim 1 and are therefore to be construed as incorporating all the limitations of claim 1. 35 U.S.C. §112. If independent claim 1 distinguishes patentably from the

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prior art and is allowable, then each of its trailing dependent claims must so distinguish and be allowable. *In re Fine*, 837 F.2d 1371, 1376, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Consequently, the following remarks will focus on the reasons why the cited references do not teach or suggest the combination of features set forth in amended claim 1. It is respectfully submitted that amended claim 1 is not taught or suggested by any of the references relied on by the Examiner, even if combined.

Rejection Based on *Buck*

The Examiner rejected claims 1-5, 9 and 11 under 35 U.S.C. §102(e) as being “anticipated” by *Buck*. In support of this rejection, the Examiner stated:

Buck teaches artificial turf comprising a primary backing having a first side and a second side and comprising a first backing layer, a second backing layer, a third backing layer, and a fourth backing layer; a plurality of fiber sewn through said primary backing; and a secondary backing on said second side of said primary backing, wherein said first layer facilitates tufting, (see figure 1-8, see column 4, line 35-45) said second layer inherently facilitates dimensional stability, said third layer inherently facilitates tuft bind and said fourth layer inherently by its presence facilitates seam strength (figure 1).

* * * *

The artificial turf fibers form a plurality of rows and columns of ribbons, the distance between each said rows being substantially the same as the distance between each of said columns.

While the Examiner indicates in the last sentence above that *Buck* discloses equal spacing between the rows and columns of fibers, no citation to such teaching in *Buck* is provided, and our review has not identified where *Buck* discloses such an arrangement for the tufted fibers. Furthermore, claim 6 was not rejected as “anticipated” by *Buck*, so it appears that this last sentence was mistakenly included by the Examiner.

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There is no teaching in *Buck* of infilled artificial turf having ribbons forming rows and columns with the spacing between the rows and the columns being substantially the same. As Applicant's specification explains, "[h]aving rows 49 and columns 48 equally spaced apart allows for a more consistent playing surface laterally and longitudinally." (Specification, page 4, lines 22-23). Accordingly, *Buck* does not teach each and every limitation of amended claim 1. Applicant respectfully requests reconsideration of the rejection of claim 1, as amended, as being "anticipated" by *Buck*.

Rejection Based on *Higgins*

Higgins does not appear to disclose equal spacing between the rows and columns of tufted fibers in artificial turf. Accordingly, *Higgins* does not disclose each and every limitation of amended claim 1. Applicant respectfully requests reconsideration of the rejection of claim 1, as amended, as being "anticipated" by *Higgins*.

Rejection Based on *Avery*

While *Avery* addresses a layered backing, it does not appear to disclose equal spacing between the rows and columns of the tufted ribbons. Accordingly, *Avery* does not disclose each and every element and limitation of amended claim 1. Applicant respectfully requests reconsideration of the rejection of claim 1, as amended, as being "anticipated" by *Avery*.

Rejection Based on *Buck* or *Avery* in View of *Tomarin*

The Examiner rejected claims 6 and 7 under 35 U.S.C. §103(a) as being unpatentable over *Buck* or *Avery* in view of *Tomarin*. The Examiner admits that *Buck* and *Avery* "[are] silent about the spacing between the tufts." However, to fill this gap, the Examiner relies on *Tomarin*, stating that:

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Tomarian teaches a grouping of tufts spaced an eighth of an inch on one side of a (column) and roughly a quarter of an inch on the opposite side (row) (Column 3 line 45-60). This is done to form a dense network (column 3 line 55-60). The examiner is interpreting this to be both substantially the same and about 3/8 inches.

It is respectfully submitted that the Examiner is improperly reading into *Tomarin* teachings not found in that reference and that it is improper to equate spacing of 1/8 of an inch with spacing of 1/4 of an inch; they are not substantially the same. *Tomarin* teaches:

The tufts themselves are closely arranged upon the backing sheet and may be threaded through the backing sheet so the tuft bights 26 are held in the backing sheet. Placing the tufts closely together, such as roughly an eighth of an inch apart in one direction and roughly a quarter of an inch apart in the opposite direction, tightly packs them together to form the dense network or mass required here. The carpet formed with these tufts is roughly between about 24-36 oz. per square yard in weight. (Col. 3, lines 48-57).

Tomarin teaches a turf system in which the spacing between the rows (1/4") is twice as wide as the spacing between the columns (1/8"). It is incorrect to assert that spacing between rows of fibers that is twice as much as spacing between the columns of such fibers are nevertheless substantially the same. Thus, *Tomarin* discloses turf in which the spacing between the rows and the spacing between the columns are not substantially the same.

To establish "obviousness": (1) the prior art itself must suggest or motivate the modification of a reference, (2) there must be a reasonable expectation of success, and (3) the prior art must teach or suggest all of the claim limitations. MPEP §2143. In this case, neither *Buck* and *Tomarin*, nor *Avery* and *Tomarin*, teach or suggest, even when combined, all of the claim limitations of amended claim 1. There is no teaching in any of the references of having the spacing between the rows and columns being substantially the same. If an individual element of a claimed combination is not present in any of the references, then the claimed invention would

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not have been “obvious” from the reference. MPEP 2143.03; *In re Serneker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-7 (Fed. Cir. 1983).

Rejection Based on *Buck* or *Avery* and *Layman*

The Examiner rejected claim 8 under 35 U.S.C. §103(a) as being unpatentable over *Buck* or *Avery* in view of *Layman*. In support of this, the Examiner stated:

Layman teaches it is known in the art to use polypropylene tape (seam tape) to adhere seams or abutting edges of panels together in synthetic turf on the second side of primary backing. This technique increases dimensional stability (column 4 line 40-65).

Again, to establish “obviousness”: (1) the prior art itself must suggest or motivate the modification of a reference, (2) there must be a reasonable expectation of success, and (3) the prior art must teach or suggest all of the claim limitations. MPEP §2143. In this case, neither *Buck* and *Layman* nor *Avery* and *Layman* teach or suggest, even when combined, all of the claim limitations of claim 8 even as originally filed. The Examiner refers to seam tape being taught by *Layman*, but does not provide any reference to the combination of stitching and seam tape being taught, as required in claim 8. And in fact, there seems to be no teaching in any of these references of providing panels that have a seam that is both sewn together and covered with seam tape. If an individual element of a claimed combination is not present in any of the references, then the claimed invention would not have been “obvious” from the reference. MPEP 2143.03; *In re Serneker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-7 (Fed. Cir. 1983).

Furthermore, when obviousness is based on the teachings of multiple prior art references, the Examiner must also establish some “suggestion, teaching, or motivation” that would have lead a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. See *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir.

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1999); *Pro-Mold v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996).

It has been consistently held that a person of ordinary skill in the art must not only have some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artist, with no knowledge of the claimed invention, would have selected these components for combination *in the manner claimed*.” (Emphasis added). And the relevant art is defined by the nature of the problem confronted by the would be inventor. *Orthopedic Equipment Co. v. U.S.*, 702 F.2d 1005, 1008, 217 USPQ 193, 196 (Fed. Cir. 1983).

In this case, the problem addressed by Applicant was how to provide an artificial turf system in which the panels could be securely joined at their edges. Applicant’s solution was to provide the combination of a layered primary backing, a sewn seam and, in addition, seam tape over the sewn seam. Applicant found that, “because of the additional strength and stability of primary backing 16, additional leftover backing material 42 is not needed to hold stitching 45 in place,” and thus seam tape could be applied over the back of the seam in addition to the stitching to form a superior seam. (See specification, page 12, line 11-page 13, line 5). In contrast, *Layman* addressed an entirely different problem, namely how to provide an improved taped seam, rather than a sewn seam. In fact, *Layman* specifically criticizes sewn seams, stating:

Various techniques have been utilized to form seams between synthetic turf materials that are applied over a pad or layer of cushioning material. Such techniques include a conventional sewing technique wherein the adjacent pieces of the turf material are actual sewn together, usually from the back. Such a procedure is extremely tedious and time consuming and often times, effects the overall appearance of the installed synthetic turf material. The sewing technique further produces localized stress points around

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the points where the thread or yarn is passed through the synthetic turf material. Overall, such a sewing technique has not been widely accepted in the installation of synthetic turf materials.”
(Col. 2, lines 12-25)(emphasis added).

Layman criticizes the use of a sewn seam and identifies the problems with sewn seams. The solution *Layman* proposes is to connect the panels with a new seam tape, rather than sewing them together. *Layman* thus provides no motivation for the idea of artificial turf having both a sewn and taped seam. In contrast, claim 8 calls for two panels of artificial turf having four layers of primary backing which have their edges both sewn and taped together at the seam. Thus, even when combined, *Buck* or *Avery* and *Layman* do not teach panels being both sewn together and having seam tape applied over the sewn seam. Furthermore, *Layman* specifically criticizes sewn seams and thus teaches away from the use of a sewn seam as called for in claim 8. Accordingly, Applicants attorney respectfully submits that, even prior to the present amendment, Applicant's claim 8 combination would not have been obvious to a person skilled in this art at the time the invention was made.

Conclusion

This Amendment is believed to be fully responsive to the Office Action of September 27, 2005, is believed to squarely address each and every ground for objection or rejection raised by the Examiner, and is further believed to materially advance the prosecution of this application toward immediate allowance.

Formal allowance of claims 1-2, 4-5 and 7-12 in light of this Amendment is, therefore, courteously solicited.

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Respectfully submitted,

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CERTIFICATE OF MAILING

I certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, this 13th day of March, 2006.

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Signed: March 13, 2006

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